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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,989	09/21/2001	Toni Markus Piponius	110686	2944
25944	7590	01/13/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER LAZARO, DAVID R	
			ART UNIT 2155	PAPER NUMBER

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/956,989	Applicant(s) PIPONIUS ET AL.	
	Examiner David Lazaro	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/14/02, 09/11/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 are pending in this Office Action.

Priority

2. This application claims the benefit of FINLAND FI-20010604 (03/23/01).
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statements (IDS) filed 03/14/02 and 09/11/02 have been considered.

Claim Objections

5. Claim 1 is objected to because of the following informalities: In line 2, "a first server, i.e. content server" should just be "a content server" for complete clarity and consistency with the remaining claims. Also, in line 4, "a second server, i.e. proxy" should just be "a proxy" for complete clarity and consistency with the remaining claims. Appropriate correction is required.
6. Claims 3 and 4 are objected to because of the following informalities: The examiner believes Claims 3 and 4 were intended to be dependent on Claim 2 and will interpret the claims as such. Appropriate correction is required.

7. Claim 7 is objected to because of the following informalities: In line 2, "billing information" should be "billing information related to the content service" for complete clarity and consistency. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 5 recites the limitation "the billing information of the access network" in line

3. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 9 is directed towards a conditional limitation, with the condition being the content provider pays for the content service. However, once the condition is met, an active step is not taken. The limitation only presents an optional choice for the content service provider, "can also pay" (emphasis added), that does not distinctly define a relationship with the claimed invention. Obviously, a content service provider may choose to pay for whatever they desire. However, the important and necessary relationship concerns how the choice is implemented or acted upon by the claimed invention. Since Claim 9 does not distinctly express this relationship, Claim 9 fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Therefore, Claim 9 is indefinite.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4, 7, 8, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,047,051 by Ginzboorg et al. (Ginzboorg).

14. With respect to Claim 1, Ginzboorg teaches a method for providing a content service to a subscriber terminal from a first server, i.e. content server, wherein the provision of the content service from the content server to the subscriber terminal is controlled by a second server, i.e. proxy, and said control of the content service provision comprises the following steps: - receiving in the proxy a service request for providing a content service (Col. 5 lines 43 - Col. 6 line 2), - determining by means of the proxy a billing address for the content service (Col. 5 lines 56-65 and Col. 7 lines 47-59) - providing the content service corresponding to the service request under the control of the proxy from the content server to the subscriber terminal (Col. 6 lines 55-63), and - generating billing information related to the content service (Col. 6 lines 3-29 and Col. 7 lines 36-59).

15. With respect to Claim 2, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the subscriber terminal is located in an access network in which

the subscriber terminal is addressed by an access network subscriber identity (Col. 5 lines 19-23 and lines 52-60), and the content server is located in a service network in which it is addressed by an IP address (Col. 4 lines 37-42), and wherein the determination of the billing address comprises the following steps: - allocating an IP address to the subscriber identity in the access network or at its edge (Col. 5 lines 52-62 - Note: The socket address of a TCP connection would contain the IP address allocated to the subscriber), - receiving in the proxy the IP address allocated to the subscriber identity (Col. 5 lines 52-62), - determining in the proxy on the basis of the received IP address the subscriber identity of the subscriber terminal and using it to determine the billing address (Col. 5 lines 52-65 and Col. 7 lines 47-59).

16. With respect to Claim 3, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the determination of the subscriber identity on the basis of the received IP address comprises an inquiry to a database in the proxy (Col. 5 line 52 - Col 6 line 2).

17. With respect to Claim 4, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the determination of the subscriber identity on the basis of the received IP address comprises an inquiry to the access network (Col. 5 line 52 - Col 6 line 2).

18. With respect to Claim 6, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the subscriber identity of the subscriber terminal is hidden from the content server (Col. 5 line 52 - Col 6 line 2).

19. With respect to Claim 7, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the generation of the billing information comprises the step of maintaining billing criteria in a database functionally connected to the proxy (Col. 6 lines 3-29).

20. With respect to Claim 8, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the billing criteria comprise the payer of the content service (Col. 6 lines 3-29 and Fig. 4).

21. With respect to Claim 11, Ginzboorg teaches all the limitations of Claim 1 and further teaches wherein the billing criteria comprise information on whether the content service in question belongs to a group of services with a special price (Col. 12 lines 42-53).

22. With respect to Claim 12, Ginzboorg teaches a proxy for providing a content service to a subscriber terminal from a content server, wherein the proxy comprises a control logic for controlling the provision of the content service from the content server to the subscriber terminal, and wherein the control logic comprises the following logic: - a first logic for determining a billing address for the content service (Col. 5 lines 56-65 and Col. 7 lines 47-59), - a second logic for providing a content service corresponding to a service request under the control of the proxy from the content server to the subscriber terminal (Col. 6 lines 55-63), and - a third logic for generating billing information related to the content service (Col. 6 lines 3-29 and Col. 7 lines 36-59).

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23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg in view of U.S. Patent 5,956,391 by Melen et al. (Melen).

25. With respect to Claim 5, Ginzboorg teaches all the limitations of Claim 1 and further teaches the forming of bills by using known methods (Col. 7 lines 50-59).

Ginzboorg does not explicitly disclose wherein the billing information related to the content service is sent to the access network to be combined with the billing information of the access network. Melen teaches a method where billing information related to content services is sent to the access network to be combined with the billing information of the access network (Col. 3 line 63 - Col. 4 line 10, and Col. 8 line 50 - Col. 9 line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Ginzboorg and modify it as indicated by Melen such that the method further comprises wherein said billing information related to the content service is sent to the access network to be combined with the billing information of the access network. One would be motivated to have this as it improves the reliability of ordering content services (Col. 3 lines 50-60 of Melen).

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26. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg in view of U.S. Patent 5,970,477 by Roden (Roden).

27. With respect to Claim 9, Ginzboorg teaches all the limitations of Claim 1.

Ginzboorg does not explicitly disclose that when a content service provider pays for the content service, the provider can also pay for telecommunication costs between the subscriber terminal and proxy. Roden teaches that when a content service provider pays for the content service, the provider can also pay for telecommunication costs between the subscriber terminal and proxy such that the use of the content service is free of charge to the subscriber (Col. 7 lines 9-17, Col. 8 lines 43-57 and Col. 9 lines 7-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Ginzboorg and modify it as indicated by Roden such that the method further comprises wherein if the content service provider pays for the content service, the content service provider can also pay for telecommunications costs between the subscriber terminal and the proxy, in which case the use of the content service is completely free of charge to the subscriber. One would be motivated to have this as there is need for flexible methods for allocating costs associated with Internet access (Col. 4 lines 32-40 of Roden).

28. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg in view of U.S. Patent Application Publication 2002/0059114 by Cockrill et al (Cockrill).

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29. With respect to Claim 10, Ginzboorg teaches all the limitations of Claim 1 but does not explicitly disclose information on whether the subscriber has been billed for the same content service, in which case the following uses of the same content service will be billed according to a lower tariff or not at all. Cockrill teaches information to determine whether the subscriber has been billed for the same content service, in which case the following uses of the same content service will be billed according to a lower tariff or not at all (Page 7 [0071], particularly step 807). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method of Ginzboorg and modify it as indicated by Cockrill such that the method further comprises wherein the billing criteria comprise information on whether the subscriber in question has already been billed for the same content service, in which case the following uses of the same content service will be billed according to a lower tariff or not at all. One would be motivated to have this as it facilitates the purchase of content and management of purchased content (Page 2 [0015] and [0016] of Cockrill).

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

31. U.S. Patent 5,905,736 by Ronen et al. "Method for the billing of transactions over the internet" May 18, 1999. Discloses the use of a transaction server that can form bills, for purchased content services, through the mapping of an IP address to a subscriber


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Identifier. The subscriber can establish multiple charge accounts and can associate billing criteria with each one.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Lazaro
January 6, 2005


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SUPERVISORY PATENT EXAMINER